

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Brian F. Fitzpatrick et al.

Art Unit 3688

Serial No. 10/675,916

Filed September 30, 2003

Confirmation No. 2091

For PLATFORM SYSTEM AND METHOD FOR EXTENDING SALES AND USE
OF A RESOURCE OF MOTIVATIONAL PROGRAMS

Examiner: Raquel Alvarez

July 2, 2008

RESPONSE TO ELECTION/RESTRICTION AND REQUEST TO WITHDRAW

TO THE COMMISSIONER FOR PATENTS,

SIR:

In the Office action dated June 5, 2008, the Examiner requires restriction to one of the following:

- I. Claims 1-24, 25-47, 63-73, 74, 75-80 and 81 drawn to permitting each participant access to a particular reward program, classified in class, 705 subclass 14.
- II. Claims 48-50, drawn to sale of a promotional program, classified in class 705, subclass 14.
- III. Claim 51-53, drawn to designing various promotional programs, classified in class 707, subclass 14.
- IV. Claim 54, drawn to consolidating client accounts of a reward program, classified in class 705, subclass 14.
- V. Claims 55-56, drawn to defining a hierarchical group of participants of a reward program, classified in class 705, subclass 14.
- VI. Claims 57-60, drawn to enrollment template for clients of a reward program, classified in class 705, subclass 14.
- VII. Claims 61-62, drawn to third party award issuer for providing awards to participants of a reward program, classified in class 705, subclass 14.

In response to the restriction requirement, Applicants hereby elect, with traverse

Group I corresponding to claims 1-24, 25-47, 63-73, 74, 75-80 and 81 for examination. Applicants reserve the right to file one or more divisional applications directed to the subject matter described in the other groups above.

Applicants request that the restriction be withdrawn as improper since all inventions are in the same subclass and would have the same field of search.

In addition, if the Examiner refuses to withdraw the requirement, reconsideration is respectfully requested of the groups and, in particular, of the reason stated in the Office action for the groupings. It is stated in the Office action that the various groups are sub-combinations of each other.

Applicants respectfully ask the Examiner to consider that even if the Examiner indeed believes that the inventions are sub-combinations, are such inventions materially different from a search perspective? Applicants respectfully submit that for purposes of issuing a restriction any such inventions cannot fairly be said to be different sub-combinations.

Applicants also ask the Examiner to consider the relative burdens on the Examiner and the Applicants. In order for a reliable search to be conducted for either group of claims, the same classes and subclasses will have to be searched. Accordingly, maintaining all claims in the application should not add more than a minimal burden. In this regard, the Examiner is asked to consider MPEP 803:

"If the search and examination can be made without serious burden, the examiner **must examine** it on the merits, even if it includes claims to distinct or independent inventions." (emphasis added)

Applicants respectfully submit that the burden of examining the additional claims having an overlapping search field cannot fairly be said to be "serious," particularly in view of the fact that there are only 15 additional claims in groups II-VII. In contrast, Applicant would incur filing and issue fees of about \$12,000 or more and maintenance fees of about \$24,000 or more if required to prosecute and maintain eight applications/patents, such fees being in addition to the similar fees to be incurred in this first application.

Finally, Applicants request regrouping to two groups: (1) claims 1-47 and 51-81 and (2) claims 48-50. Claims 51-53 relate to "designating ..." and correspond to claims

7-9 and 30-32 of group I so that they should be examined with group I. Claim 54 relates to "consolidating ..." and corresponds to claims 10 and 33 of group I so that it should be examined with group I. Claims 55-56 relate to "hierarchical ..." and correspond to claims 13, 14, 36 and 37 of group I so that they should be examined with group I. Claims 57-60 relate to "participant information ..." and correspond to claims 6, 15, 21, 29, 38 and 44 of group I so that they should be examined with group I. Claims 61-62 relate to "award neutral ..." and correspond to claim 59 so that they should be examined with group I.

In view of the foregoing, Applicant respectfully asks the Examiner to withdraw or modify the restriction.

The Commissioner is hereby authorized to charge any deficiency or overpayment of any required fee in connection with this response to Deposit Account No. 19-1345.

Respectfully submitted,

/Frank R. Agovino/

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